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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,542	02/06/2002	Bo. T. Claridge	5007260-2	8006

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/068,542

Applicant(s)
Claridge et al.

Examiner
O'Connor

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 4, 2004
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 6, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on August 4, 2004 in reply to the previous Office action, mailed March 1, 2004.
2. The amendment of claims 1 and 9, cancellation of claims 2 and 3, and addition of claims 12-28 by applicant on August 4, 2004 are hereby acknowledged.

Election/Restriction

3. Newly submitted claims 14-28 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

The invention defined by claims 1-13 (Invention I) and the invention defined by claims 14-20 (Invention II) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In this case, Invention II has separate utility from Invention I, such as for use with multiple investment accounts without any point of sale location. See MPEP § 806.05(d).

The invention defined by claims 21-28 (Invention III) is related to Invention I as combination and subcombination. Inventions in this relationship are distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as

claimed for patentability, *and* (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this case, the combination as claimed does not require the particulars of the subcombination as claimed, because a system in accordance with Invention III need not include any pre-determined dollar investment amount for the on-demand investment. The subcombination has separate utility, such as for making a contribution to an investment account of an investor at a time of making a purchase, wherein the investor has only a single investment account.

4. Since applicant has received an Office action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claims 14-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

5. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-13 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject

matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to require the use of any technology, such as claims 1-13, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 6,112,191), in view of Barton (US 6,164,533).

Burke discloses a method of investment comprising the steps of: receiving a request to complete an on-demand investment transaction in response to an action by a purchaser at a point-of-sale location; retrieving investment-preference information for the purchaser; and,

completing the on-demand investment using the investment-preference information. See, in particular, Figures 4A, 4B, and 4C. The disclosure of Burke, though, does not specifically teach that the investment-preference information includes any predetermined dollar investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale.

However, Barton discloses a similar method of investment, which method indeed includes that the investment-preference information includes a predetermined dollar investment amount for the on-demand investment. See, in particular, column 5, lines 44-50.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include in the investment-preference information a predetermined dollar investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in achieving a budgeted investment goal by suggesting a default investment amount for each purchase being made.

Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment request until a predetermined completion time. See, in particular, column 3, lines 4-13.

Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the

maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary/alternate investment account. However, Barton discloses a similar method of investment, which method indeed includes contributing the on-demand investment request to an investment account having a limit/maximum (an IRA). See, in particular, column 5, lines 44-50. Since canceling a deposit or rolling it over to a secondary/alternative account are self-evident and well known, hence obvious, steps to perform in order to avoid exceeding a limit/maximum of an investment account having a limit/maximum, such as an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum, in accordance with the teachings of Barton, and to accommodate the investment limit/maximum by not exceeding it, by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary or alternate investment account, as is self-evident and well known to do, in order to obey the law by complying with limits/maximums imposed on certain investment accounts, such as IRAs, by the law, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 9-11, the method of Burke comprises associating a purchasing account with an investment account and using either the purchasing account or a source other

than the purchasing account to contribute to the investment account. See, in particular, column 12, lines 11-16.

Regarding claim 12, the method of Burke includes receiving, from the purchaser at the point-of-sale location, a request to specify the dollar investment amount. Therefore, the combination described above with respect to claim 1 would inherently include the step of receiving, from the purchaser at the point-of-sale location, a request to modify the predetermined dollar investment amount, since simply specifying an amount is equivalent to modifying a predetermined amount of zero to any non-zero amount.

Regarding claim 13, the method of Burke includes adding the investment amount to a transaction amount, during processing of a point-of-sale transaction. Therefore, the combination described above with respect to claim 1 would inherently include the step of adding the predetermined dollar investment amount to the transaction amount, during processing of the point-of-sale transaction.

Response to Arguments

9. Applicant's arguments filed August 4, 2004 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "an

investment amount of a predetermined dollar amount that is independent of the point-of-sale transaction”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner’s supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to “Commissioner of

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Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

November 22, 2004

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(11-22-04)" in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627